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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/163,634	06/07/2002	Thanh Ta	111325-230400	8116
22204 7590 02/18/2010 NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128				
EXAMINER				
AUGUSTIN, EVENS J				
ART UNIT		PAPER NUMBER		
3621				
MAIL DATE		DELIVERY MODE		
02/18/2010		PAPER		

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THANH TA,
THOMAS DEMARTINI,
JOSEPH Z. FUNG,
GUILLERMO LAO,
MAI NGUYEN,
BIJAN TADAYON,
VINCENT TIEU,
DUC TRAN,
XIN WANG, and
EDGARDO VALENZUELA

Appeal 2009-008881
Application 10/163,634
Technology Center 3600

Decided: February 18, 2010

Before MURRIEL E. CRAWFORD, ANTON W. FETTING, JOSEPH A.
FISCHETTI, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Thanh Ta, et al. (Appellants) seek review under 35 U.S.C. § 134 (2002) of a final rejection of claims 1-9, 18-21 and 23-28. Claims 10-17 and 22 have been cancelled.

We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

Appellants claim a system and method for managing use of protected resources within a system of resources. (Specification: 3)

Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A method for managing use of protected resources within a system of resources, said method comprising:

granting access to a protected resource by a principal when pre-conditions associated with the protected resource and the principal are satisfied,

wherein the satisfaction of said pre-conditions is only required before the principal accesses the protected resource;

permitting the principal to continue to access the protected resource only as long as during-access conditions associated with the protected resource and the principal are satisfied, said during-access conditions being distinct from said preconditions,

wherein the satisfaction of said during-access conditions is only required after the principal accesses the protected resource and before the access to the protected resource terminates; and

terminating access to the protected resource by the principal when a termination event occurs, said termination event comprising the satisfaction of post-conditions distinct from said during-access conditions,

wherein the satisfaction of the post-conditions is only required after the access to the protected resource terminates.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Stefik	US 5,629,980	May 13, 1997
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The following rejection is before us for review.

The Examiner rejected claims 1-9, 18-21, and 23-28 as being anticipated under 35 U.S.C. § 102(b) by Stefik.

ISSUE

Have Appellants shown that the Examiner erred in rejecting claims 1-9, 18-21, and 23-28 as being anticipated by Stefik in that the post-conditions are distinct from the during-access conditions given that the value(s) of the loan period and/or copy counts are different in each condition, and thus are distinct as required by the claims?

PRINCIPLES OF LAW

Anticipation

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

FINDINGS OF FACT

We find the following facts by a preponderance of the evidence:

1. The Examiner found with respect to the claim limitations:

"permitting the principal to continue to access the protected resource only as long as during-access conditions associated with the protected resource and the principal are satisfied, said during-access conditions being distinct from said preconditions; wherein satisfying the during-access conditions is only required after the principal accesses the protected resource and before the access to the protected resource terminates"; that Stefik discloses this feature:

During the accessing (col35, lines 66-67), the system checks to see if the loan period has been exhausted, and to see if the number of copies to be loaned is valid, also check to see if number of copies permitted are valid (column 36, lines 3-14), if those conditions are satisfied, continue to access content (column 3 1, lines 59-60). During Access, different than pre access conditions(pre access: Satisfies security checks (column 3 1, lines 38-45), Request is valid (column 35, lines 43-46), During Access: Loan period is not exhausted (column

36,3-5), Number of copies in use less than
requested (col 36, lines 8-13)

(Answer 12: Appendix A; Table 1, row 3, col. 2)

2. The Examiner found that Stefik discloses the claim limitation of:
“terminating access to the protected resource by the principal when a
termination event occurs, said termination event comprising the satisfaction
of post-conditions distinct from said during-access conditions, wherein the
satisfaction of the post-conditions is only required after the access to the
protected resource terminates”, in that:

If the loan period is exhausted (termination event), then
the user is deactivated from the system and the content is
erased (post conditions) from the user's memory (column
36, lines 8-14, lines 15-22). A Termination event is when
a loan period exhausted (column 36, lines 15-22).
Interpreting post access conditions as erasing or
removing content from memory, which does not happen
until after the user is deactivated (consistent with
appellant's specification in par. 50, where "a post
condition is the removal of access to the resource after an
exercise limit has been reached, when the limit is reached
the resource is deleted or some other action is taken
which disables or prevents access")

(Answer 12: Appendix A; Table 1, row 6, col.2)

3. Stefik discloses :

The check of the usage rights essentially involves a
determination of whether a right associated with
the access request has been attached to the digital
work and if all conditions associated with the right
are satisfied. If the access is denied, repository 1
terminates the session with an error message, step
106. If access is granted, repository 1 transmits
the digital work to repository 2, step 107. Once
the digital work has been transmitted to repository

2, repository 1 and 2 each generate billing information for the access which is transmitted to a credit server, step 108. Such double billing reporting is done to insure against attempts to circumvent the billing process.

Stefik: col.7 ll. 25-36.

4. Stefik discloses

Assuming that the copy count does not equal zero, the server checks if the copies in use for the requested right is greater than or equal to any copy count for the requested right (or relevant parts), step 1809. If the copies in use is greater than or equal to the copy count, this indicates that usage rights for the version of the transaction have been exhausted. Accordingly, the server terminates the transaction, step 1805. If the copy count is less than the copies in use for the transaction the transaction can continue, and the copies in use would be incremented by the number of digital works requested in the transaction, step 1810.

Stefik: col. 31, ll. 52-62

4. Stefik discloses that “[t]he specifications components 1452 are used to specify conditions which must be satisfied prior to the right being exercised or to designate various transaction related parameters.” Stefik: col.18, ll. 33-35.

5. The Examiner found with respect to claims 2 and 3 that “[t]he system uses digital content such as audio, video, text, or software (column 6, lines 39-40) and uses rendering devices (means) such as printers to render the content into its desired form (column 8, lines 23-33).” (Answer 4).

6. The Examiner found with respect to claim 29 that Stefik discloses a method specification indicating a manner by which the value of the state variable can be obtained from a device so that the value can be used to

determine whether the pre-conditions, during-access conditions, and post-conditions are satisfied in that:

[t]he requester sends the server a message to initiate the Transfer Transaction. This message indicates the work to be transferred, the version of the transfer right to be used in the transaction, the destination address information for placing the work, the file data for the work, and the number of copies involved.

The repositories perform the common opening transaction steps.

The server transmits the requested contents and data to the requester according to the transmission protocol. If a Next-Set-Of-Rights has been provided, those rights are transmitted as the rights for the work. Otherwise, the rights of the original are transmitted. In either case, the Copy-Count field for the transmitted rights are set to the number-of-copies requested.

The requester records the work contents, data, and usage rights and stores the work.

The server decrements its copy count by the number of copies involved in the transaction.

The repositories perform the common closing transaction steps.

If the number of copies remaining in the server is now zero, it erases the digital work from its memory.

Stefik: col. 35, ll. 6-29.

ANALYSIS

We affirm the rejection of claims 1-9, 18-21 and 23-28.

Initially, we note that the Appellants argue claims 1, 4, 6-9, 23 and 24 together as a group. Correspondingly, we select representative claim 1 to decide the appeal of these claims, remaining claims standing or falling with claim 1.

Appellants' arguments against each of the independent claims are based on perceived deficiencies of Stefik. Inasmuch as Appellants raise the same issues with respect to each of these claims, we discuss them together, addressing each of Appellants' arguments in turn.

A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. See, 37 C.F.R. § 41.37 (c)(1)(vii) (2004)

Appellants argue that:

...Stefik fails to disclose the satisfaction during-access conditions after principal accesses the protected resource but before access is terminated, AND the satisfaction post-conditions only after access to the protected resource terminates, wherein the post-conditions are distinct from the during-access conditions.

(Appeal Br. 7)

We disagree with Appellants' assertion that Stefik fails to disclose the required satisfaction of during access and post conditions. We find that the Examiner made findings that show that Stefik discloses the required satisfaction of during access and of post-conditions. (FF 1-2). The Examiner further found that in Stefik either the loan period or copy-count conditions could be read as the during-access or post conditions. (Answer 12: Appendix A; Table 1, rows 4,5,6), Appellants however argue that the Examiner has improperly analogized the copy count conditions as equatable to post-conditions of the invention because "[a]ccess to the resource would not be granted if the copies in use are greater than the copy count of the request (1809), since the transaction is otherwise immediately terminated (1805)." (Appeal Br. 7, 8). We disagree with Appellants because the copy

count condition is a contingent condition which allows access to the content “if the copy count is less than the copies in use for the transaction [and thus] the transaction can continue, and the copies in use would be incremented by the number of digital works requested in the transaction, step 1810. (FF 4)

Even using one of the loan period or copy-count conditions as both the during-access or post conditions, we find that both the loan period and the copy count have different values when taken as access and post conditions, and hence are distinct as required by the claims.

Regarding claims 25 and 27, Appellants argue that

After careful review of the Office Action of October 21, 2005, Appellants note that Examiner fails to distinctly point out the section(s) of the Stefik reference or other prior art that allegedly discloses the device recited in independent claim 27. Thus, the Examiner fails to provide support for a prima facie case of anticipation.

Appeal Br. 10.

We disagree with Appellants because we find that the Examiner has set forth a comprehensive claim chart (Answer 12) citing to Stefik by column and line number to the process steps of claim 1 which correspond to those functions set forth in the means-plus-function recitations in claim 27.

For example, the Examiner found with respect to the granting access function that Stefik discloses this feature at column 18 lines 33-35. (Answer 12). This section of Stefik discloses that the involved device in Stefik is the specific component 1452 which is used to specify conditions which must be satisfied prior to the right being exercised or to designate various transaction related parameters. (FF 4). We thus find this presentation sufficient to establish the elements of anticipation against claims 27 especially in light of

Appellants' similar type of citing made in their SUMMARY section of the Brief on pages 4-5 for the required citations for specific elements of the means plus function language. We therefore sustain the rejection of claims 25 and 27, and claims 26 and 28 which depend therefrom, respectively.

With regard to claims 2 and 3, the Examiner found that "[t]he system uses digital content such as audio, video, text, or software (column 6, lines 39-40) and uses rendering devices such as printers to render the content into its desired form (column 8, lines 23-33)". (FF 5)

Appellants however argue that

When derived resources are derived from protected content such as an encrypted file, the derived resources may include, but are not limited to a clear, unencrypted image and the memory address of the image. (*See* Specification: ¶ 22). In this example, the clear image (a derived resource) is the resource that can be used for rendering the protected content. Clearly, this example is distinguishable from the Examiner's assertion

We disagree with Appellants because Appellants' Specification describes, in one scenario the content is in usable form *e.g.*, unencrypted, we thus chose this scenario to meet the claim limitation where the rendering devices (printers) can use the data as a derived resource.

Regarding claim 5, this claim recites in pertinent part "said during-access conditions are applied to said primary resource and said derived resources."

Appellants argue first that, conditions are not disclosed as applied to both a primary and a derived resource in the manner claimed in dependent claim 5; and second, that usage rights are clearly distinct from conditions, such as during-access conditions. (Appeal Br. 12).

We disagree with Appellants, as to the first point. We find that Stefik would necessarily function such that the conditions which control the primary source and would inherently control the downstream derived source because the latter is tied to the conditions of the former. “It is well settled that a prior art reference may anticipate when the claim limitations not expressly found in that reference are nonetheless inherent in it. [...] ‘Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates.’” *In re Cruciferous Sprout Lit.*, 301 F.3d 1343, 1349, (Fed. Cir. 2002) (citations and internal quotation marks omitted). As to point 2, Appellants’ argument thus fails because Appellants use of the term “usage rights” is not recited in the claims. “[A]ppellant’s arguments fail from the outset because [] they are not based on limitations appearing in the claims.” *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982).

Claim 18 recites in pertinent part

providing a condition specification adapted to associate conditions with the protected resource to control the protected resource, said specification including:

a resource designation indicating the protected resource that the pre-conditions, during-access conditions, and post-conditions are associated with;

a state variable indicating a status of the resource with respect to the pre-conditions, during-access conditions, and post-conditions; and

a method specification indicating a manner by which the value of the state variable can be obtained from a device so that the value can be used to determine whether the pre-conditions,

during-access conditions, and post-conditions are satisfied.

The Examiner found that status conditions are state variables which can be obtained from devices as described by Stefik at col.35, lines 6-29. (Answer 5). We agree with the Examiner. We find that Stefik's count status is a state variable in that it conveys information about the machine state. This is because Stefik discloses a message which includes data about "the work to be transferred, the version of the transfer right to be used in the transaction, the destination address information for placing the work, the file data for the work, and the number of copies involved." (FF 4).

Appellants however argue that "Stefik does not disclose a method specification that includes the location of state variables, appropriate communication protocols, and any parameters needed to obtain the value of a state variable in the manner claimed in dependent claim 18." (Appeal Br. 18). However, the Appellants' arguments "fail from the outset because . . . they are not based on limitations appearing in the claims . . .," because claim 18 does not recite "appropriate communication protocols". *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982).

Appellants further argue that the "method specification can include the location(s) where values of state variables are stored (such as a remote server that manages a condition). (Appeal Br. 14). However, we find that Stefik at column 35 lines 6-29 similarly discloses a server, a location, at which in response to a message to initiate the Transfer Transaction, the count status is decremented (FF 6). In light of the breadth of the claim, the Appellants' arguments are not persuasive as to error in the rejection.

Appellants' arguments as to claim 21 rely on those asserted for claim 18 which found unpersuasive.

Claim 19 recites in pertinent part wherein said method specification includes a location of a device on which the value of the state variable is stored.

The Examiner found that “The method indicates the destination address to stored (*sic*) the content and state variables (column 35, lines 9-11) (Answer 5).

Appellants argue that “[t]he method specification of claim 19 includes the location of a device on which a state variable is stored. This is not the same as the destination address information for placing work as suggested by Stefik.” (Appeal Br. 15).

We disagree with Appellants. We find that the server sets the copy count to the number-of-copies requested (FF 4), and thus stores this value as required by the claims. We thus read the server as the location on which the value of the state variable is stored. The server also stores the destination address of the device which will receive the content as also required by the claims.

Claim 20 recites in pertinent part said method specification includes a communication protocol for obtaining the value of the state variable.

Appellants argue that “[c]laim 20 is distinguishable over Stefik, because claim 20 recites including the applicable communication protocol within the method specification for obtaining the value of a state variable.” (Appeal Br. 16) We disagree with Appellants. We find that Stefik discloses a server which we read as including the required method specification. Since the communication from the server to the requester via a communication protocol causes the server to decrement its copy count by the number of copies involved in the transaction, it thus meets the required

claims language. In light of the breadth of the claim, the Appellants' argument is not persuasive as to error in the rejection.

We therefore will not sustain the rejection of claim 18 or claims 19-21 which depend therefrom

CONCLUSIONS OF LAW

We conclude the Appellants have not shown that the Examiner erred in rejecting claims 1-9, 18-21 and 23-28 as being anticipated under 35 U.S.C. § 102(b) by Stefik is affirmed.

DECISION

To summarize, our decision is as follows.

The decision of the Examiner to reject claims 1-9, 18-21 and 23-28 is AFFIRMED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

mev

Appeal 2009-008881
Application 10/163,634

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